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No. 252

In the

Supreme Court of the United States

October Term, 1963

HARRY A. TOULMIN, JR.,
Petitioner,

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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CITATIONS

No citations appear in the body of the Brief.

The authorities cited to the Courts below are set out in Appendices I and II 10, 13

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The Petition for Certiorari is believed to be so clearly without substance on the merits, and to fall so far short of the requirements of Rule 19 of this Court, that respondents will confine themselves to the following Counter-statement of Questions Presented and brief recital of facts not furnished, or only partially furnished, to the Court in the Petition.

COUNTER-STATEMENT OF QUESTIONS PRESENTED

I. Is the acknowledged quotation of a sentence and a half from a historical account in the Foreword of a novel

set against the background of the historical event a fair use where:

a. The material quoted was neither a substantial nor material part of the copyrighted work and did not in any degree prejudice the sale, diminish the profits or supersede the objects of the original work;
b. Such material had no effect whatsoever on the acceptance or sale of the accused novel; and
c. Plaintiff himself had followed in the copyrighted historical work the same pattern of acknowledged quotation which he charges as copyright infringement by the author here.

II. Is the charge of copyright infringement *de minimis* under the circumstances of Question I, where:

a. The copyrighted work had been out of print for some 22 years and there were and are no plans to republish it;
b. Plaintiff knew and stated that interest in the work had long since been exhausted;
c. The quotation was not charged as copyright infringement by the then owner of the copyright;
d. Plaintiff procured a purported assignment of the copyright without consideration and on representations that he wanted it for sentimental reasons; and
e. The total retail value of the copies sold by defendants was less than $400.00.

RESPONDENTS' STATEMENT OF THE CASE

The words charged as an infringement appear as an acknowledged quotation in the Foreword to a novel, *They Came To Cordura*, written by Glendon Swarthout and having the historical background of General Pershing's 1916

Punitive Expedition into Mexico against Pancho Villa. The book has nothing to do with either Pershing or Villa, except that the imaginary events of the novel are related as having occurred during the campaign. The book was published in a hard-cover edition in 1958 by Random House, Inc., and a paper-back reprint in 1959 by New American Library, both of New York City. The excerpt in the Petition is insufficient to show that Swarthout was clearly quoting what Swarthout wrote is:

> "Of the terrain, one officer, writing twenty years later, concluded that 'If God had set out to mold a country as a stage for a cavalry campaign, he would have made . . . Chihuahua. This was a stage five hundred miles long and a hundred miles wide, across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors.'" (Foreword to both Ptf's Ex. F (phys.) and Dft's Ex. 6 (phys.) (Page at which offered not printed. Fdg 10, Petit. p. 10))*

The quoted words are from a historical account of the Expedition written by Toulmin entitled *With Pershing In Mexico*, and which is concerned wholly with Villa and Pershing's Expedition. A single edition of the book was published in 1935 by Military Service Publishing Company of Harrisburg, Pennsylvania, and quickly went out of print. There were not and have never been plans or intentions to republish or reprint it and, in Toulmin's words, ". . . interest in it has long since been exhausted and there are no more copies . . . available". (Fdg. 2, Petit. p. 8; Dfts' Ex. 4, Appdx. 22b, 41b).

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* References to physical exhibits are identified by their exhibit numbers at the trial, to those portions of proceedings below included as Appendices to the Petition for Certiorari by page number in the Petition, and to the portions of proceedings below not reproduced in the Petition but appearing in ptf's Appendix to the Court of Appeals, by the Appendix page numbers followed by "a", and in dfts' Appendix to the Court of Appeals by the Appendix page numbers followed by "b".

The pertinent text of the Toulmin book appears at page 6 of the Petition and is repeated here for convenience. The parts used in *Cordura* are in italics:

> "*If God had set out to mold a country as a stage for a cavalry campaign, he would have made* the plains, the streams, the ranches and mountains of *Chihuahua*—barren wastes, green oases, sterile sand, mud; magnificent mountains, mean adobe villages, fertile ranches and rich mines. All the grandeur of poverty, the misery of politics and the fury of Latin passions—that is Mexico. It was upon this enormous stage of the plains against the back drop of the Sierra Madre mountains that Pershing and Villa played their game of hide and seek. *This was a stage five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors.*" (Ptfs. Ex. E (phys.) p. 17; see Appd. p. 15b).

Thus more was omitted than was quoted. The District Court found the quoted portion to be insignificant in value and extent of the work from which quoted, and neither a substantial nor material part of it. Correspondingly, the Court found that the quotation did not affect acceptance or sale of the novel (Fdgs. 18-21, Petit. pp. 11-12.)

In the historical account, Toulmin himself had followed exactly the same pattern which is the sole basis of his present charge of copyright infringement against *Cordura*, stating at page 47 of such account that:

> ". . . the swiftly moving panorama of this campaign, which was, as one officer expressed it (followed by a longer quotation than the words quoted from *Pershing*)" Ptfs Ex. E (phys.) p. 47; Fdg. 17, Petit. p. 11, page at which offered not printed.)

Thus in writing his own book, Toulmin recognized and followed the widely accepted practice of quoting briefly

from earlier works on historical and factual matters, but charges infringement when this same practice was followed by another. Our position is not that infringement by one justifies infringement by another, but that use of this kind is a common practice, not infringement, and that Toulmin so recognized it in following the practice himself.

When *Cordura* was published, Toulmin did not own the copyright on *Pershing*. It was owned by the original publisher, Military Service Publishing Company. That company did not then, or ever, advance any claim of alleged infringement. Toulmin, however, following publication of both editions of *Cordura*, obtained a purported assignment of the copyright, without consideration, as a result of the following representations in a letter which he wrote Military Service:

> "For sentimental reasons, I would like very much to have the assignment by you to me, of the copyright on ('*With Pershing in Mexico*'). I presume that the interest in it has long since been exhausted and there are no more copies of this book available." (Dfts. Ex. 4, Apdx. 22b-23b, 41b).

This assignment was no more than colorable because it was not by Military Service, but by The Stackpole Company, Inc. Plaintiff made no attempt in the trial record to connect Stackpole with Military Service; thus there is a complete failure of title in plaintiff to maintain the action.

The Courts below found on the merits that the situation constituted a clear case of of (1) fair use, and (2) *de minimis*, without necessity for reaching the question of title. (Distr. Ct. Fdgs. 18-21, Petit., pp. 11, 12; Ct. Ap. Dec., Petit., p. 13). Thus the question so emphasized by plaintiff in the Petition as to an alleged right to minimum damages under 17 U.S.C.A. 101(b) is not present in the case. Damages do

not follow from bringing suit, but only from establishing infringement. Plaintiff recognized this in the Courts below and never raised the question in the District Court or in its Notice of Appeal, or even in its Main Brief on appeal.*

In the assignment obtained ostensibly "for sentimental reasons," which Toulmin prepared, he included the right to sue for past infringement. Promptly upon obtaining it, he filed the Complaint herein, and did so without giving notice of alleged infringement; defendant Rike-Kumler, the leading department store in Dayton, Ohio, learned of the suit from a newspaper account. (Fdg. 9; Petit. p. 9; Appd. 6b). Miami Valley News is a distributor of paperback books for the area. Both defendants are local Dayton organizations.

At the time of trial neither defendant had had a copy of *Cordura* for more than a year and had no intention of further sales of the book, and there have been none. Their total sales were less than 20 copies of the hard-cover edition, and 600 of the paper-bound edition, with a total retail value of under $400. (Appd. 5b-6b, 8b; Fdg. 6, Petit. p. 9).

The District Court, after a full trial, found that the sentence and a half from *Pershing* quoted some 22 years later by Swarthout in *Cordura* was "neither a substantial nor material part of (*Pershing*)", that it was "insignificant in value and extent of the copyrighted material", and further that it "did not in any degree prejudice the sale, diminish the profits or supersede the objects of" the original historical account. The evidence completely supports the findings and there is no contrary evidence. On this basis the Court held the quotation to be a "fair use". (Fdgs. 18; Petit. p. 11).

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* The earliest reference to 17 U.S.C.A. 101(b) in the suit was in plaintiff's reply brief to the Court of Appeals and was characterized by that Court during oral argument as "an afterthought".

Equally significant, having in mind that the trial Court heard the testimony of both Toulmin and Swarthout and observed the demeanor of both authors on the stand, is the trial Court's finding that:

> "The clear facts and the only possible inferences that can reasonably be drawn from them establishes beyond possibility that this case is a clear case of *de minimis*." (Fdg. 21, Petit. p. 12).

The Court of Appeals for the Sixth Circuit, after Briefs and argument before it by counsel, affirmed in a *per curiam* decision. (Petit. p. 13).

ARGUMENT

It is respectfully submitted that on these facts, which are uncontested, each of the following reasons, considered separately, is a complete basis for denial of certiorari:

1. The decision is clearly right on the merits as to fair use: the quotation meets all the customary standards by which fair use is measured by the Courts and there are no reasonable inferences to the contrary. Applicable authorities are set out in Appendix I hereto, p. 10 infra.
2. Equally clearly, the decision is right on the merits as to *de minimis*. Plaintiff recognized that "... interest in (the *Pershing* book) has long since been exhausted. . .", and the book had been out of print for twenty-two years without intention to reissue or republish it. The copyright owner gave no indication at all that it considered there had been an infringement, and plaintiff obtained the purported assignment on the representations that it was essentially valueless, and that he wanted it "... for sentimental reasons." He accepted the assignment from a com-

pany not the owner of record and made no attempt to connect his actual assignor with the owner of record. He then promptly filed suit against a local Dayton retailer and a distributor whose combined total sales were only a few hundred dollars. Two courts have decided these circumstances are *de minimis* and we submit they could not properly have held otherwise.

3. The first full paragraph on page 4 of the Petition raises a spurious issue by misstating first the doctrine of fair use and then that of *de minimis*. Fair use does include direct quotations (Auth. in Appdx. II, infra p. 11), from which it follows that it is not inconsistent with *de minimis*. The Courts below treated the doctrines properly as cumulative.

4. All other reasons aside, the decision was plainly right because of plaintiff's total failure to show he owned the copyright. There is a clear break in the chain of title.

5. Infringement is a tort, and whether or not it was committed is a question of fact. Two courts have decided this question for defendants. The facts here are not challenged: the evidence of both plaintiff and defendant was consistent and uncontradicted. Plaintiff has not cited any decision indicating an error of law: to the extent that it is applicable, the only decision he does cite is authority for defendants.

6. Not a single consideration under Rule 19 indicating desirability of certiorari is present. The Court of Appeals decision is not in conflict with the decision of any other Court. It does not decide an important question of Federal law which has not been, but should be, settled by this Court: this Court has long since settled the basic proposition of copyright law that to constitute infringement there must

be copying of a portion substantial in substance, or extent, or both, and neither criterion is met by the facts here. The Court of Appeals did not decide the question here in a way in conflict with applicable decisions of this Court, but in accordance with them. And certainly there has been no departure from the accepted and usual course of judicial proceedings; the District Court gave full and careful consideration to the evidence and law, and the Court of Appeals decision similarly was made after full briefing and oral argument.

The number of errors and misstatements in the Petition is such that they should not go unnoted. They are set out in Appendix II hereto (p. 11 infra.)

CONCLUSION

Plaintiff's position, it is submitted, is conspicuously lacking in equity. It is respectfully requested that the Petition be denied.

Respectfully submitted,

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.

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RESPONDENTS' APPENDIX I

Authorities on Fair Use

Court Decisions:

Bloom & Hamlin v. *Nixon*, 125 Fed. 977. E.D. Pa., 1903.

Broadway Music Corporation v. *E-R Publ. Co.*, 31 F. Supp. 817, 818, S.D. N.Y., 1940.

Columbia Pictures Corp. v. *National Broadcasting Co.*, 137 F. Supp. 348, 353, S.D. Cal. 1955.

Dymow v. *Bolton*, 11 F.2d 690, 691, 2nd Cir. 1926.

Eggers v. *Sun Sales Corporation*, 263 Fed. 373, 2nd Cir. 1920.

Eisenschiml v. *Fawcett Publications*, 246 F.2d 598, 603, 7th Cir. 1957, c.d. 355 U.S. 907.

Green v. *Minzensheimer*, 177 Fed. 286, S.D.N.Y., 1909.

Harold Lloyd Corporation v. *Witmer*, 65 F. 2d 1, 4, 9th Cir. 1933, dismissed 296 U.S. 699.

Hill v. *Whalen & Martell, Inc.*, 220 Fed. 359, S.D.N.Y. 1914.

Karll v. *Curtis Publ. Co.*, 39 F. Supp. 836, 837, E.D. Wis., 1941.

Kustoff v. *Chaplin*, 120 F. 2d 551, 560, 9th Cir. 1949, and auth. cited.

Mathews Conveyor Co. v. *Palmer-Bee Co.*, 135 F. 2d 73, 84, 85, 6th Cir. 1943.

Perris v. *Hexamer*, 99 U.S. 674, 675-6, U.S.S.C. 1879.

Shapiro, Bernstein & Co., Inc. v. *Collier & Sons Co.*, 26 USPQ 40, 43, S.D.N.Y. 1934 (not offic. reptd.)

Tralins v. *Kaiser Aluminum & Chemical Corp.*, 160 F. Supp. 511, 515, D.Md., 1958.

Other Authorities:

18 *Corpus Juris Secundum*, p. 219.

Amdur, *Copyright Law and Practice*, Chap. 22, p. 754 ff.

Ball, *Law of Copyright and Literary Property*, Chap. XI, pp. 259 ff.

Drone, *Copyright*, p. 414.

Howell's *Copyright Law* (Latman Revision) pp. 151 ff.

Shafter, *Musical Copyright* (2nd. ed.), pp. 240 ff.

Weil, *American Copyright Law*, pp. 429 ff.

RESPONDENTS' APPENDIX II

Errors and misstatements appearing in the Petition, at the following pages:

p. 1. Plaintiff's Appendix does not set out the provisions of 28 U.S.C.A. 1254, but portions of annotations Nos. 1, 2, 3 and 6 thereto appearing at pages 44-46 of the 1949 edition of 28 U.S.C.A., §§ 1251-1330 inclusive. The only pertinent section is 28 U.S.C.A. 1254, sub-division 1, which is:

> § 1254. Courts of appeals; certiorari; appeal; certified questions
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

pp. 2, 4, 7. From the proceedings in both Courts below, it is self-evident that they applied the doctrine of *de minimis*, not with respect to the amount of material copied, as the Petition states, but as their respective evaluations of the trifling nature of plaintiff's alleged cause of action—we submit by reason

of the propriety of Swarthout's actions as a later author referring to an earlier historical account, of plaintiff's own practices as an author, and of the circumstances under which plaintiff purported to acquire the right to sue.

pp. 2-4 Plaintiff's ostensible summary of the presently applicable law misstates each proposition. Flatly contrary to the Petition, the decisions and the text writers, cited under the foregoing Appendix, are that "Copying of a SUBSTANTIAL portion is essential. . . . for infringement of a copyright." (Emph. in orig.) (*Kutsoff*, supra, 560); that "The test. . . . is not primarily a quantitative one. The question is one of quality rather than quantity (etc.)" (*Columbia Pictures Corp.*, supra, 353), and that ". . . a substantial copy of the whole, or a material part, must be reproduced. . . On the principle of de minimis non curat lex, it is necessary that a substantial part of the copyrighted work be taken." (*Mathews Conveyor*, supra, 84). There is no contrary authority.

p. 3 We find the somewhat surprising statement that the Court has made ". . . few, if any, decisions on the subject of copyright infringement, since . . . 1878. . . ." (Petit. p. 3). The Court's decision in *Perris v. Hexamer* was in fact decided on the basis that "The defendant has not copied (plaintiff's) maps" (p. 676), i.e., which is a qualitative and not a quantitative basis.

p. 3 Swarthout did not admit, but denied, that the quoted material was of any importance, and as to "leavening" "the entire content of (*Cordura*)", the District Court held that the material ". . . had no effect whatsoever on the acceptance" of that book, (Fdg. 19, Petit. p. 12).

p. 4 Contrary to the Petition, fair use is not limited to general themes, but extends to direct quotation, as matters both of clear authority:

Bloom & Hamlin v. *Nixon*, 125 Fed. 977. E.D. Pa., 1903.

Broadway Music Corporation v. *F-R Publ. Co.*, 31 F. Supp. 817, 818, S.D. N.Y., 1940.

Eisenschiml v. *Fawcett Publications*, 246 F.2d 598, 603, 7th Cir. 1957, c.d. 355 U.S. 907.

Green v. *Minzensheimer*, 177 Fed. 286, S.D.N.Y. 1909.

Shapiro, Bernstein & Co., Inc. v. *Collier & Sons Co.*, 26 USPQ 40, 43, S.D.N.Y. 1934 (not offic. reptd.)

and of common practice in everyday experience.

p. 4. Also contrary to the Petition, as to the qualitative content of the material quoted the District Court, affirmed by the Court of Appeals, specifically held that the quoted portion was "neither . . . substantial nor material" and was ". . . insignificant in value and extent (of *Pershing*)" and that it "did not relate to (the) theme (of the Toulmin book) at all." It held correspondingly that such portion had "no effect whatsoever on the acceptance or sale of (*Cordura*)". (Fdgs. 18.)

p. 6. The second full paragraph is grossly misleading. In his Foreword, Swarthout stated that he was quoting from "One officer, writing twenty years later" and used quotation marks to show the portion quoted. Contrary to the Petition, the trial Court flatly found that:

> "The sentences used had no effect whatsoever on the acceptance or sale of the 'Cordura' book. . . ."

(Fdg. 19, Petition p. 12).